

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/805,185
Attorney Docket No. Q63490

REMARKS

Claims 1-11 have been examined in the application.

I. Allowable Subject Matter

Applicant thanks the Examiner for allowing claims 6 and 8-11.

II. Obviousness Rejections

A. Claims 1-3 and 5:

The Examiner maintains the rejection of claims 1-3 and 5 under 35 U.S.C. § 103(a) as being obvious over Barbera et al. (U.S. Patent No. 6,364,556).

In the Examiner's Response to Arguments, the Examiner takes the position that Barbera teaches that commercially available parts, such as an LED, optical emitter, etc., can be selected and tailored to any specific implementation and also states that by using an emitter on one side of a sheet paired with a photo-receptor on the opposite side of the sheet will give an indication of the total light being transmitted across the paper. For at least the following reasons, Applicant respectfully disagrees with the Examiner's position, and therefore, traverses this rejection.

It is settled law that a prior art reference must be considered in its entirety. *W.L. Gore & Associates, Inc., v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); see also MPEP 2141.03. That is, the Examiner must consider statements in the reference in the context of the teachings of the reference. For example, Barbera states that commercially available LED

and photo-receptor elements can be employed in the invention of Barbera and that these elements can be selected or tailored to any specific implementation (see col. 4, lines 9-12). However, Barbera goes on to state that the selection or design is based on the wavelength and intensity of light needed for the various forms of paper used with the printer, and that the LED has to have an output beam capable of penetrating at least two sheets of the densest media (see col. 4, lines 12-18). In other words, Barbera is not disclosing that the invention of Barbera can be modified to be used for applications other than a transmissible paper sensor. Instead, Barbera merely is identifying that commercially available LED and photo-receptor elements can be employed in the invention of Barbera and that these elements can be selected or tailored based on the wavelength and intensity of light needed for the various forms of paper used with the printer, such that, for example, the LED has an output beam capable of penetrating at least two sheets of the densest media. Barbera does not, however, disclose or suggest that the transmissible paper sensor can be modified to arrive at different devices, such as the claimed invention.

Further, even if the Examiner considers this statement to apply to different devices, other than the transmissible paper sensor of Barbera, this statement is (at best) merely a general statement that commercially available parts can be used to make any number of unidentified or undisclosed devices. However, this general and open-ended statement of Barbera clearly does not provide the specificity required to establish a *prima facie* case of obviousness with respect to the claimed invention. See *In re Lee*, 61 USPQ2d 1430, 1433 (CAFC 2002)(The need for specificity pervades this authority), citing *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317(Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with

no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”). Therefore, for at least the foregoing reasons, Applicant submits that the Examiner has not established a *prima facie* case of obviousness.

Additionally, the Examiner takes the position that Barbera discloses that accurate positioning can be quickly and easily performed, as allegedly disclosed at col. 2, lines 30-40. For at least the following reasons, Applicant respectfully disagrees with the Examiner’s characterization of Barbera.

Contrary to the Examiner’s position, Barbera does not disclose that accurate positioning can be quickly and easily performed, as alleged by the Examiner (see Office Action, page 4, numbered paragraph 6). Instead, Barbera merely discloses that some of the advantages of the invention of Barbera are: (1) the detection of multiple print media, (2) the detection of leading edge and trailing edges, (3) the detection of top-of-form and bottom-of-form, (4) the detection of media edge in full-bleed printing, and (5) improvements in hard copy apparatus throughput. That is, considering Barbera in its entirety, Barbera is disclosing merely the advantages of a transmissible paper sensor that is concerned with the problem of detecting overlapped print media as being different than a single sheet. However, Barbera neither discloses nor suggests that accurate positioning of an image-receiving sheet and a transfer sheet that are superimposed on each other can be quickly and easily performed. In fact, Barbera does not even mention anywhere in its disclosure that the transmissible paper sensor of Barbera can assist with accurate positioning of an image-receiving sheet and a transfer sheet that are superimposed on each other, as recited in independent claim 1.

As an example, Applicant submits that (assuming *arguendo*), if an image-receiving sheet and a transfer sheet that are superimposed on each other were inserted into the device of Barbera, the device of Barbera merely would identify (at best) that the sheets were overlapped (i.e., more than one sheet has been inserted), which is the object of the Barbera reference. In fact, Barbera would issue an error message (i.e., two sheets have been inserted) with every attempt to feed the image-receiving sheet and a transfer sheet into the device of Barbera. However, Barbera would not identify whether the overlapped sheets were positioned accurately with respect to each other. Therefore, Applicant submits that, to arrive at the claimed invention, a substantial modification of the Barbera reference would be required. That is, a substantial reconstruction and redesign of the elements of Barbera, as well as a change in the basic principle under which Barbera was designed to operate, would be necessary to arrive at the claimed combination.

Additionally, Applicant submits that, assuming *arguendo*, even if Barbera could be modified to arrive at the claimed invention, it would not have been obvious to modify Barbera in such a way as to arrive at the claimed combination. That is, the mere fact that a reference can be modified does not render the claimed combination obvious unless the prior art also suggests the desirability of the modification.

Furthermore, Applicant submits that the Examiner has not provided any motivation or suggestion, either explicitly or implicitly, for modifying Barbera to arrive at Applicant's claimed combination. That is, mere conclusory statements that it would have been obvious to modify Barbera to arrive at the claimed invention are not sufficient to establish a *prima facie* case of obviousness.

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For the foregoing reasons, Applicant submits that the Examiner has not established a *prima facie* case of obviousness; and therefore, the rejection of independent claim 1 (and dependent claims 2, 3, and 5) should be withdrawn.

B. Claim 4:

The Examiner maintains the rejection of claim 4 under 35 U.S.C. § 103(a) as being obvious over Barbera and Murazaki et al. (U.S. Patent No. 5,859,496).

For at least the foregoing reasons, Applicant submits that Barbera does not teach or suggest all of the recitations of independent claim 1, from which claim 4 depends. Therefore, claim 4 is patentable over the applied references at least by virtue of its dependency from claim 1. Additionally, Applicant submits that claim 4 separately and independently is patentable over any combination of the applied references.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103(a) is whether the claimed invention as a whole would have been obvious. See *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); see also MPEP 2141.02. Additionally, the factual inquiry whether to combine references must be thorough and searching and it must be based on objective evidence of record. This precedent has been reinforced in myriad decisions and cannot be dispensed with. See *In re Lee*, 61 USPQ2d 1430, 1433 (CAFC 2002), citing *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an

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obviousness holding’”) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“teachings of references can be combined only if there is some suggestion or incentive to do so.”) (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

In the present case, the Examiner alleges that Murazaki discloses that a fluorescent substance on a light emitting member is beneficial since it provides illumination in the event of a power outage, which allegedly is one of many uses for fluorescent substances in the art of printing. However, the Examiner has not provided an explanation with respect to the reasons that a person of skill in the art would have: (1) modified Barbera to provide an insertion platform for an image transfer apparatus, as recited in claim 1, and (2) further modified Barbera to include a light accumulation fluorescent substance that is coated on at least one of the light transmission member and its periphery, as recited in claim 4.

For example, Murazaki relates to an afterglow lamp for emergency lamps that can emit light without a reserve electric source. However, the Examiner has not provided an explanation

with respect to whether Barbera, if modified to include a fluorescent substance, could operate for its intended purpose in the case when the LCD was not supplied with power. That is, the Examiner's position is that it would have been obvious to include the fluorescent substance in the event of a power failure. However, without a power source, the device of Barbera would not function at all. Therefore, Applicant submits that it would not be reasonable to incorporate the fluorescent substance of Murazaki to provide light for use in Barbera during a power failure, since Barbera would not operate at all if the device were not receiving power.

Thus, to establish a *prima facie* case of obviousness, some reasonable suggestion or motivation for modifying Barbera based on the teachings of Murazaki must be provided, either in the references themselves, or in the art in general. Applicant respectfully submits that the Examiner has not, however, provided any such motivation. Therefore, Applicant submits that the Examiner has not established a *prima facie* case of obviousness with respect to claim 4; and thus, the rejection of claim 4 should be withdrawn.

C. Claim 7:

The Examiner maintains the rejection of claim 7 under 35 U.S.C. § 103(a) as being obvious over Barbera and Takekoshi (U.S. Patent No. 6,120,199).

For at least the foregoing reasons, Applicant argues that Barbera does not teach or suggest all of the recitations of independent claim 1, from which claim 7 depends. Therefore, claim 7 is patentable over the applied references at least by virtue of its dependency from claim

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1. Additionally, Applicant argues that claim 7 is patentable separately and independently over any combination of the applied references at least by virtue of the additional recitations therein.

As set forth above, in determining the differences between the prior art and the claims, the question under § 103 is whether the claimed invention as a whole would have been obvious. The factual inquiry whether to combine references must be thorough and searching and it must be based on objective evidence of record and there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant.

In this case, the Examiner makes a conclusory statement that it would have been obvious to combine the allegedly well known device disclosed by Takekoshi with the device of Barbera, without objective evidence or an explanation as to the suggestion or motivation for combining Barbera and Takekoshi to arrive at the specific combination of elements recited in claim 7. That is, notwithstanding the well known devices disclosed in Barbera and Takekoshi, the Examiner still must provide a suggestion or motivation, either in the references themselves or in the prior art in general, to combine these references in a manner that would lead to the device recited in claim 7, not merely that the devices are well known and could be combined. Applicant respectfully submits that the Examiner has not provided any such suggestion or motivation, and therefore, has not established a *prima facie* case of obviousness with respect to claim 7.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the


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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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